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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/730,841

12/05/2003

Thoms M. Coon

03084

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7590

09/28/2006

EMCH, SCHAFFER, SCHAUB & PORCELLO CO  
P O BOX 916  
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TOLEDO, OH 43697

EXAMINER

SWIGER III, JAMES L

ART UNIT

PAPER NUMBER

3733

DATE MAILED: 09/28/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/730,841	<b>Applicant(s)</b> COON ET AL.	
	<b>Examiner</b> James L. Swiger	<b>Art Unit</b> 3733	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 23 June 2006.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) 8-14 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 15-19 is/are allowed.
- 6) ☒ Claim(s) 1-7 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 05 December 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>3/29/2004</u> .   | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Election/Restrictions***

Applicant's election without traverse of Invention I, claims 1-6 and 15-19 in the reply filed on 6/23/2006 is acknowledged.

Claims 8-14 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on 6/23/2006.

Note that applicant's arguments with regards to the species election in the reply filed 6/23/2006 has been considered and is persuasive. The species election has been withdrawn.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-2 are rejected under 35 U.S.C. 103(a) as being unpatentable over McDaniel (US Patent 4,501,266) in view of Vinciguerra et al. (US Patent 5,554,158). McDaniel discloses an adjustment/positioning device having an elongated housing (4), a passageway extending through the housing (see Fig. 2 on the right), a post that is positioned in the passageway for axial movement (9) and a portion that is being considered the outwardly extending flange (8), defining both a first and second edges,

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and that would fit in the gap formed by two condylar surfaces (see relative size in Fig. 1). Together, the post and flange may also be rotated from a first to a second position (see col. 4, lines 1-17).

McDaniel discloses the claimed invention except for specifically a condylar engagement member at a distal end of the housing (in the direction of the flange) that fits a first and second condylar engagement surface. Vinciguerra et al. disclose two condyle articulating surfaces (36 and 38) that allow the device to fit properly onto the surface of the femoral condyle (Col. 2, lines 50-61). It would have been obvious to one having ordinary skill in the art at the time the invention was made to construct the positioning apparatus of McDaniel having at least two condylar engagement members in view of Vinciguerra et al. so the device has a better fit on the surface of the prosthesis.

Claims 3-5 are rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of McDaniel '266 and Vinciguerra et al. '158 as applied to claim 1 above, and further in view of Hackett (US Patent 2,362,957). The combination of McDaniel '266 and Vinciguerra et al. '158 disclose the claimed invention except for a rod having threads that would move the flange toward or away from the main body, a means to prevent rotation of the post, or an abutment therein preventing rotation but allowing axial movement. Hackett disclose a rod with threads that allows movement of the flange (9), a means or abutment (8) that prevents rotation but allows axial movement, up and down, along slot G. See also Col. 2, lines 1-20). It would have been obvious to one having ordinary skill in the art at the time the invention was made to construct the device

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of the combination of McDaniel '266 and Vinciguerra et al. '158 having at least a threaded rod, abutment/anti-rotation means with axial movement in view of Hackett to better maneuver and the device when trying to provide adjustment.

Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of McDaniel '266 and Vinciguerra et al. '158 and Hackett '957 as applied to claim 3 above, and further in view of Ferrante et al. (US Patent 5,275,603). The combination of McDaniel, Vinciguerra et al. and Hackett disclose the claimed invention except for a diagonal slot extending for receiving a tool. Ferrante et al. disclose a diagonally extending slot (82) that may be used to drive a portion of the device, such as a handle, which may function as a tool (see Col. 4, lines 10-38). It would have been obvious to one having ordinary skill in the art at the time the invention was made to construct the device of the McDaniel, Vinciguerra et al. and Hackett having at least a diagonally extending slot in view of Ferrante et al. to better allow the device to be adjusted in use with a tool.

Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of McDaniel, Vinciguerra et al. and Hackett as applied to claim 3 above, and further in view of Mikhail (US Patent 5,180,384). The combination of McDaniel, Vinciguerra et al. and Hackett disclose the claimed invention except for a handle portion at the proximal end having an abutment for receiving a tool. Mikhail disclose a proximal end portion that has two inwardly concave surfaces (above the 45's in Fig. 1), that form an abutment on top, that is capable of providing a tool access to manipulating the device. See also Col. 4, lines 58-60). It would have been obvious to one having ordinary

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skill in the art at the time the invention was made to construct the device of the combination of McDaniel, Vinciguerra et al. and Hackett having at least an abutment portion in view of Mikhail to better adjust the device in use.

***Allowable Subject Matter***

Claims 15-19 are allowed.

***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. See PTO-892.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to James L. Swiger whose telephone number is 571-272-5557. The examiner can normally be reached on Monday through Friday, 9:00am to 5:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eduardo Robert can be reached on 571-272-4719. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



JLS

9/12/2006



EDUARDO C. ROBERT  
SUPERVISORY PATENT EXAMINER